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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/618,794	07/18/2000	James Norman Cawse	RD-26357	8865

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EXAMINER

PRASTHOFER, THOMAS W

ART UNIT	PAPER NUMBER
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1627

DATE MAILED: 12/31/2001

11

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**  
*file copy*

Application No.

09/618,794

Applicant(s)

CAWSE, JAMES NORMAN

Examiner

Thomas W Prasthofer

Art Unit

1627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08/30/01 and 10/09/01.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 and 26-35 is/are pending in the application.
- 4a) Of the above claim(s) 1-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 26-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 30 August 2001 is: a) ☒ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

## **Detailed Action**

### **Status of the Application**

Receipt is acknowledged of a response to an office action with amendment on 30 August 2001 (Paper No. 8) and a supplemental amendment on 09 October 2001 (Paper No. 10). The corrections to the drawings submitted in Paper No. 8 are accepted. Formal drawings reflecting the corrections are required.

### **Status of the Claims**

Claims 1-25 were pending in the present application. Claims 1-15 have been withdrawn from further consideration in Paper No. 7. Claims 16-25 were cancelled and new claims 26-35 were added as per applicant's request in Paper No. 8.

Claims 26-35 are pending in the present application and examined on their merits.

### **Withdrawn Rejections / Objections**

1. All outstanding rejections are withdrawn in response to applicant's cancellation of all examined claims.

### **Objections to the Claims**

2. New claim 31 is objected to because it appears to be missing the word "to" in line 1 between "proximate" and "said."

### **New Grounds of Rejection**

The statutory basis for the following rejections can be found in an earlier office action.

**New Grounds of Rejection – 35 U.S.C. 112, second paragraph**

3. New claims 26-35 (formerly applied to claims 16-25) are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: relationships between a vessel, charge port, discharge port, and reaction chamber. For example, is the reaction chamber contained within the vessel? Are the ports in communication with the reaction chamber through the vessel or independent of the vessel?

Applicant argues that the rejection, as applied to claims 16-25, is overcome by writing new claims 26-35 in subparagraph form, “whereby said relationships are clarified.”

Applicant’s argument has been carefully considered and found not to be persuasive. The new claims still do not provide definitive cooperative relationships between a vessel, charge port, discharge port, and reaction chamber. For example, may the charge and discharge ports be the one and the same?

**Claims Rejections – 35 U.S.C. 102**

4. New claims 26 and 27 (formerly applied to claims 16 and 17) are rejected under 35 U.S.C. 102(b) as being anticipated by Cody et al. (1994) U.S. Patent No. 5,324,483.

The Cody et al. reference discloses an apparatus for the chemical synthesis of compounds (abstract). The apparatus comprises a manifold (vessel) with a plurality of ports adapted to serve as inlet and outlet ports for materials to be introduced into and recycled out of the manifold (charge and discharge ports) (column 9, lines 16-36). The apparatus comprises a reservoir rack (reaction chamber) in communication with the manifold ports via reaction tubes (column 8, lines 23-57). The reservoir rack is sized to receive a series of removable reaction wells (vials) which are disposed linearly (in rows).

Applicant argues that a key feature of the claimed apparatus is its “*capability of sequentially receiving and discharging a plurality of discrete reactant combinations and products thereof*,” and that the apparatus disclosed by Cody et al. “*lacks any capability of sequentially receiving and discharging reactant combinations and their products.*”

Applicant's arguments filed 30 August 2001 have been fully considered but they are not persuasive. The apparatus of the cited Cody et al. reference can sequentially receive pluralities of discrete reaction combinations (i.e. it can be re-used). There is no language in the pending claims that excludes an apparatus in which the charge and discharge ports are the same and in which products must be removed before the next set of reaction combinations is received.

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Thomas Prasthofer** at telephone number **(703) 308-4548**. The examiner can normally be reached on Monday, Tuesday, Friday, and Saturday 8:00-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jyothsna Venkat can be reached on (703) 308-2439. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-2742.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist at (703) 308-1235.

Thomas Prasthofer, Ph.D.  
12/19/01



PADMASHRI PONNALURI  
PRIMARY EXAMINER  
for SPE